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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/722,174	11/25/2000	Kia Silverbrook	NPA081US	3854

24011 7590 12/30/2004

SILVERBROOK RESEARCH PTY LTD
393 DARLING STREET
BALMAIN, 2041
AUSTRALIA

EXAMINER

GRAHAM, CLEMENT B

ART UNIT	PAPER NUMBER
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3628

DATE MAILED: 12/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/722,174

Applicant(s)

SILVERBROOK ET AL.

Examiner

Clement B Graham

Art Unit

3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-47 remained pending.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-19, 21, 23-24, 26-40, 42-44 and 46 are rejected under 35 U.S.C. 102(b) as being anticipated by the Perazza patent (5,326,959).

The Perazza patent discloses a method of enabling bill payment of bills comprising the steps of providing a person with a bill containing information relating to a payment (cot. 11, lines 1-13 receiving indicating data from a sensing device (cot. 16, lines 29-54 and cot. 11, lines 1822); and identifying at least one parameter relating to the payment (cot. 16, lines 24-54).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action: (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 148 USPQ 459, that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or unobviousness.

6. Claims 20, 41 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Perazza patent in view of the PCT application WO 99/50787 (XEROX).

The Perazza patent discloses all the elements of the claimed invention, as stated above, except the data being substantially invisible (claims 20 and 45) and the sensing device having a marking nib (claim 41). The XEROX reference teaches the data being

substantially invisible (page 8, lines 23-25) and the sensing device having a marking nib (505, page 14, lines 10-19). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the Perazza patent to have substantially invisible data so as to interfere with other visible markings on the bill and to have a sensing device with a nib so that should marks be necessary on the bill, they can be made at the time of reading the bill with the sensing device.

7. Claim 22, is rejected under 35 U.S.C. 103(a) as being unpatentable over the Perazza patent in view of the Story patent (5,673,430). The Perazza patent discloses all the elements of the claimed invention, as stated above, except the bill using a mixture of multicast and pointcast communication protocols (claim 22). The Story patent teaches the use of multicast and pointcast communication protocols (col. 3, lines 14-19). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the Perazza patent to use multicast and pointcast communication protocols so as to reduce operating costs.

8. Claims 25 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Perazza patent in view of the Japanese Patent Abstract 10194562 A.

The Perazza patent discloses all the elements of the claimed invention, as stated above, except the binding of a multipage bill (claims 25 and 47). The Japanese patent abstract reference teaches the binding of multiple pages of the bill (Solution portion of Abstract). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the Perazza patent to have a means of binding a bill having multiple pages so that the various pages will remain together and reduce the opportunity for them to become separated.

Conclusion

Response to Arguments

9. Applicant's arguments filed on 04/26/2004 have been fully considered but they are not persuasive for the following reasons.

10. In response to Applicant's arguments as it pertains to Perazza, XEROX, Story and Japanese Patent Abstract 10194562 A.

11. In response to applicant's argument that Perazza fail to teach or suggest " a computer system receives indicating data from a sensing device regarding to identity of the bill and a position of sensing device relative to the bill determining movement of a sensing device relative to the bill and in particular does not described determining movement of sensing device based on data provided on the bill" The Examiner disagrees with Applicant's because these limitations are addressed as stated.

The Perazza teaches a method of enabling bill payment of bills comprising the steps of providing a person with a bill containing information relating to a payment (cot. 11, lines 1-13; receiving indicating data from a sensing device cot. 16, lines 29-54 and cot. 11, lines 18-22 and identifying at least one parameter relating to the payment cot. 16, lines 24-54. It is obviously clear that these are by limitations are addressed.

12. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., that are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

13. "As stated in *re Geiger*, 815 F.2d 686, 2 U.S.P.Q.2d 1276 (Fed. Cir. 1987), "obviousness cannot be established by combining teachings of the prior art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting combination." (emphasis added)(attached as appendix 2)" (Page 5, line 9).

EXAMINER'S RESPONSE: This is a court decision of an appeal of a decision made by the USPTO Board of Patent Appeals and Interferences, which affirmed obviousness rejections of an application for a patent.

Appellant's citation of this decision is unrelated to the factual circumstances of Appellant's claims and disclosure and to the logic of the rejections. In *re. Geiger* concerns itself with a technical invention in the chemical arts involving a applicant's claim of unexpected results. At issue was the validity of the Office's claim to a prima facie case of obviousness. In the instant case, we are not dealing with points of scientific data presented by Applicant. The Examiner only has to present a logical argument that a combination of prior art will be successful, that the combination has a

reasonable chance of success, and that the combination will not result in conflicting elements. Applicant then has the burden of disproving the Examiner's argument. In spite of these inappropriate circumstances of In Re. Geiger, Appellant does quote the court's argument supporting obviousness rejection, by quoting "obviousness cannot be established ... absent some incentive supporting combination" (page 5, lines 9-11). In this instance, the incentive to combine is strong, as cited in the obviousness rejections above.

14. In response to applicant arguments against the references individually, one cannot show nonobviousness by attacking the reference individually where the rejections are based on a combination of references. See In Keller, 642 F.2d, 208 USPQ 871 (CCPA 1981); In re Merk & Co., 800 F.2d 1091, 231 USPTQ 375 (Fed. Cir. 1986).

15. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

16 Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clement B Graham whose telephone number is 703-305-1874. The examiner can normally be reached on 7am to 5pm.

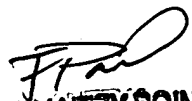
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Sough can be reached on 703-308-0505. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-0040 for regular communications and 703-305-0040 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

CG

December 27, 2004


FRANZY POINVIL
Priority Examiner
AU 3628